

**REMARKS**

**The Claimed Invention**

The claimed invention is directed to diagnostic methods for drug screening for Alzheimers.

**The Pending Claims**

Prior to entry of the above amendments, Claims 1 and 3-26 are pending.

**The Office Action**

Claims 1 and 3-25 are rejected.

Claim 26 is allowed.

**Amendments**

The amendments have been made as suggested by the Examiner.

**Response to the objections and rejections**

In the response that follows, the Examiner's individual objections and rejections are provided in full text, as identified by indented small bold print, followed by Applicant's response.

**Objection***Priority Claim*

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. (ss)120 as follows:
5. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation in part) between the applications except when the reference is to a prior application of a CPA assigned the same application number

The subject application was filed as a continuation of prior application USSN 09/193,221 filed November 16, 1998. In the Transmittal for the subject application, Applicants specifically requested that the specification be amended to refer to the prior application (*see* page 3 of the attached copy of the Transmittal filed July 14, 1999). The correct year of filing of the prior application appears on page 1 of the Transmittal; there is an error in the information on page 3 of the Transmittal. The information is corrected above and the current status of the prior application updated.

*Specification*

6. The disclosure is objected to because of the following informalities: misspellings "0.fl mV" (pp.4 line 9), "thre" (pp .4 line 27) and unclear abbreviation "1sec" (pp. 9 line 12).  
Appropriate correction is required

The informalities have been corrected as indicated above.

*Drawings*

7. The drawings are objected to because Figure 5 is missing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. The Applicant is reminded to avoid the introduction of new matter. (see 35 U.S.C. (ss)112).

The subject application was filed as a continuation of prior application USSN 09/193,221 filed November 16, 1998. As required under 37 CFR 1.63 (d), the specification is identical to that of the prior application. The prior application lacked Figure 5. A petition under 37 CFR 1.181 was

**PATENT**

**ATTORNEY DOCKET NO. CSHL.005.01US**

made requesting that a filing date be accorded to the prior application since the missing Figure was not necessary to the understanding of the claimed invention. A copy of the petition is attached hereto.

35 U.S.C. §112 Rejection


The written description and enablement rejections are believed avoided by amendment of the claims as suggested by the Examiner. Applicants state for the record that for the reasons already made of record that the claims as previously presented are enabled by the specification and also that the specification meets the written description requirement. They reserve the right to prosecute the cancelled subject matter in one or more subsequent applications.

**CONCLUSION**

In view of the above response and amendment, it is submitted that this application is now in form for allowance. Early notice to that effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (831) 648-3090.

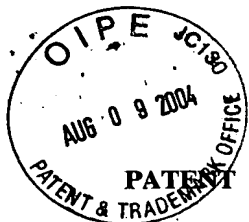
Respectfully submitted,

Dated: August 3, 2004

  
\_\_\_\_\_  
Barbara Rae-Venter, Ph.D.  
Reg. No. 32,750

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BRV/mnb



FILE

COPY

ATTORNEY DOCKET NO. CSHL.005.01US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Roberto Malinow *et al* ) Examiner: Not yet assigned  
Serial No.: Not yet assigned ) Art Unit: Not yet assigned  
Filed: July 14, 1999 ) UTILITY PATENT APPLICATION  
For: **Diagnostic Methods for Drug Screening** ) TRANSMITTAL (37 C.F.R.  
**for Alzheimer's Disease** ) § 1.53(b))

**BOX PATENT APPLICATION**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

This is a request for filing a patent application under 37 C.F.R. § 1.53(b) in the name of inventors: Roberto Malinow, Sahid Zaman, Sangram S. Sisodia, David R. Borchelt, and Michael K. Lee

For: **Diagnostic Methods for Drug Screening for Alzheimer's Disease**

This application is a ☒ Continuation ☐ Divisional ☐ Continuation-in-part of prior Application No.: 09/193,221 filed November 16, 1998, from which priority under 35 U.S.C. § 120 is claimed.

Application Elements:

- 14 Pages of Specification, Claims and Abstract  
4 Sheets of **formal** Drawings

CERTIFICATE OF EXPRESS MAILING

"Express Mail" Label No.: EL288327221US

Date of Deposit: 7/14/99

I hereby certify under 37 C.F.R. 1.10 that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" with sufficient postage on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

(Signature)

ANDREA JOHNSON  
(Printed Name)

- ☒ Declaration  
☐ Unexecuted Combined Inventor Declaration and Power of Attorney  
☒ Copy from prior application (37 CFR 1.63(d) for a continuation or divisional).

The entire disclosure of the prior application from which a copy of the declaration is herein supplied is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

- ☐ Deletion of inventors Signed statement attached deleting inventor(s) named in the prior application, *see* CFR 1.63(d)(2) and 1.33(b).

Accompanying Application Parts:

- ☐ Assignment and Assignment Recordation Cover Sheet (recording fee of \$40.00 enclosed)  
☐ Power of Attorney  
☐ 37 CFR 3.73(b) Statement by Assignee  
☐ Information Disclosure Statement with Form 1449  
☐ Copies of IDS Citations  
☐ Preliminary Amendment  
☒ Return Receipt Postcard  
☒ Small Entity Statement(s)  
☒ Statement filed in prior application.  
Status still proper and desired.  
☐ Other:  
☐ A sequence listing.  
☐ paper copy.  
☐ computer readable copy.  
☐ Statement in Compliance with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence.

Claim For Foreign Priority

- ☐ Priority of \_\_\_\_\_ Application No. \_\_\_\_\_ filed on \_\_\_\_\_  
is claimed under 35 U.S.C. § 119  
☐ The certified copy has been filed in prior application U.S. Application No. 09/193,221  
☐ the certified copy will follow.

Extension of Time for Prior Pending Application

- ☐ A Petition for Extension of Time is being concurrently filed in the prior pending application. A copy of the Petition for Extension of Time is attached.

Amendments

- ☒ Amend the specification by inserting before the first line the sentence: "This is a ☒ Continuation ☐ Continuation-in-part ☐ Divisional application of copending prior
- ☒ Application No. 09/193,221 filed on November 16, 1999.
- ☐ International Application \_\_\_\_\_ filed on \_\_\_\_\_, which designated the United States, disclosure of which is incorporated herein by reference."
- ☐ Cancel in this application original claims \_\_\_\_\_ of the prior application before calculating the filing fee

Fee Calculation (37 CFR § 1.16):

	(Col. 1)	(Col. 2)	<u>SMALL ENTITY</u>		<u>OTHER THAN A SMALL ENTITY</u>	
<u>FOR:</u>	<u>NO. FILED</u>	<u>NO. EXTRA</u>	<u>RATE</u>	<u>FEE</u>	<u>RATE</u>	<u>FEE</u>
Basic Fee			\$380	\$380	\$760	\$
Total Claims	12	0	\$ 9	\$	\$ 18	\$
Indep Claims	4	1	\$ 39	\$ 39	\$ 78	\$
<input type="checkbox"/> Multiple Dependent Claims			\$130	\$	\$260	\$
Total Filing Fee:				\$419		\$

**TOTAL FEES: \$419.00**

- ☒ A check including the amount of the above-indicated TOTAL FEES is attached.
- ☐ Please charge Deposit Account No.18-0020 in the amount of \$\_\_\_\_\_.
- ☐ A check in the amount of \$\_\_\_\_\_ is attached.
- ☐ No fee is required.
- ☒ Conditional Petition for Extension of Time: An extension of time is requested in the present and/or the above-referenced parent application to provide for timely filing if an

extension of time is still required after all papers filed with this transmittal have been considered.

- ☒ The Commissioner is hereby authorized to charge any underpayment of the following fees associated with this communication, including any necessary fees for extension of time, or credit any overpayment to Deposit Account No. 18-0020.
- ☒ Any filing fees under 37 CFR 1.16 including fees for the presentation of extra claims.
- ☒ Any parent application processing fees under 37 CFR 1.17.
- ☒ A **duplicate** copy of this sheet is attached for accounting purposes.

Respectfully submitted,

Dated: July 14, 1999

By: Barbara Rae Venter  
Barbara Rae Venter, Ph.D.  
Reg. No. 32,750

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BRV/kmb  
Enclosures



PATENT

ATTORNEY DOCKET NO. CSHL.005.00US

**COPY**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s):	Roberto Malinow, <i>et al.</i>	) Examiner:
		)
Serial No.:	09/193,221	) Art Unit:
		)
Filed:	November 16, 1998	)
		)
For:	DIAGNOSTIC METHODS FOR	)
	DRUG SCREENING FOR	)
	ALZHEIMER'S DISEASE	)
		)

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COMMISSIONER OF PATENTS AND TRADEMARKS  
WASHINGTON, DC 20231

Dear Sir:

PETITION UNDER 37 CFR §1.181

Applicants' attorney petitions the Honorable Commissioner to confirm the filing date accorded the subject application.

A filing date was accorded the subject application. The cover sheet and postcard did not indicate that drawings were included, but the application does refer to 5 figures. It is possible that the drawings accompanied the application when filed and that two errors were committed: failure to indicate the presence of the drawings with the documents; and the loss of the drawings at the Patent Office. However, since the situation is not free from doubt, applicants' attorney is filing this petition.

I hereby certify that this paper or fee is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 on July 16, 1999.

Signature: Barbara Rae-Venter

Printed Name: Barbara Rae-Venter



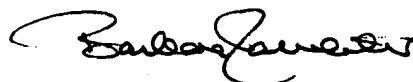
Accompanying this response is an amendment canceling the references to the drawings. Since the drawings are unnecessary for a complete description of the invention, the filing date accorded the subject application should be confirmed.

The claimed subject invention is a method for screening drugs for treatment of Alzheimer's disease. The methodology employed is based on published procedures. The figures are graphs whose data are extensively set forth in the specification in the description of the figures. The data set forth are adequate for demonstrating the results and providing a comparison for the results obtained to results which might be obtained in the future. In addition, there is verbal description of the methodology, in addition to the literature directions, direction one would expect for the results for an effective drug, as well as standards to be used. See particularly, page 8, line 1 to page 9, line 29.

The drawings are unnecessary for an understanding of the methodology, the nature of the cells used and the anticipated results for effectiveness of a drug. The drawings graph the results reported in the literature and merely provided a convenient assembly of the data. Copies of the drawings are submitted herewith for the Examiner's convenience, but not for completing the application as filed.

In view of the above remarks, the Honorable Commissioner is respectfully requested to confirm the filing date accorded the subject application and direct prosecution of this application. The appropriate fee accompanies this petition.

Respectfully submitted.



Bertram I. Rowland, Ph.D.

Reg. No. 20,015 *Reg. No. 32,750*



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# **United States Patent and Trademark Office**

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The information provided by you in this form will be subject to the following routine uses:

- (1) The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. § 552) and the Privacy Act (5 U.S.C. § 552(a)). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
- (2) A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- (3) A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual when the individual has requested assistance from the Member with respect to the subject matter of the record.
- (4) A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform the contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. § 552a(m).
- (5) A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. § 2904 and § 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.